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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Sylvain ORENGA et al. Group Art Unit: 1657

Application No.: 10/552,508 Examiner: L. HOBBS

Filed: October 5, 2005 Docket No.: 125292

For: MEDIUM FOR DETECTING AND/OR IDENTIFYING MICROORGANISMS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the January 9, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 1-5, 6-11, 15 and 16, with traverse.

Applicants respectfully submit that the Office Action fails to establish that a lack of unity of invention exists between the media of Groups I, II, and III. PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after

taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Furthermore, unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

> Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

> If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

The Office Action asserts, "The inventions listed in Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: each medium for detecting and its corresponding method has its own specially adapted features, steps, substrates, and inhibitors, etc.

However, PCT Rule 13.4 expressly states that "subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim, even where

the features of any dependent claim could be considered as constituting in themselves an invention."

Moreover, although unity of invention practice under PCT Rule 13 recognizes that alternate forms of an invention may be present in separate independent claims, or in a single claim, restriction between distinct embodiments of a single claim may only be required if there is a lack of unity of invention in that claim, or, in other words, the distinct embodiments share no common subject matter that defines a contribution over the prior art. *See* ISPE 10.09; MPEP §1850(II).

Accordingly, Applicants respectfully submit that a unity of invention analysis does not hinge upon whether there are patently distinct embodiments or species (i.e., "each medium for detecting and its corresponding method has its own specially adapted features, steps, substrates, and inhibitors, etc.") but rather whether the distinct embodiments share no common subject matter that defines a contribution over the prior art (special technical feature). However, the Office Action fails to establish that the embodiments defined in Groups I-III lack common subject matter.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, in other words, after a search of the prior art has been conducted and it is established that all of the elements of independent claim 1 are known. *See* ISPE 10.07 and 10.08. However, the Office Action fails to provide any references showing that the subject matter common to the embodiments defined by Groups I-III (for which at least claim 1 is generic) was known in the prior art and, thus, fails to establish *a posteriori* that a lack of unity of invention exists between the embodiments of Groups I-III. Therefore, the Office Action has not met its burden in establishing a lack of unity of invention.

Because the Office Action has not demonstrated a lack of unity of invention under the rules, the Restriction Requirement is improper. Accordingly, reconsideration and withdrawal of the Restriction Requirements are respectfully requested.

Respectfully submitted,

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